

**Remarks/Arguments**

Reconsideration of this application is requested.

The Examiner has objected to certain informalities in claim 20.

Applicant had amended claim 20 to overcome the informalities.

Claims 1, 5-21, 23-29, 32, 34, 37-40, 42, 43, 47, 51 and 52, have been rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Cordery, et al. (U.S. Patent No. 5,628,249) in view of Humes, et al. (U.S. Patent No. 5,377,120). Applicant respectfully submits that Cordery patent is not available as prior art against the instant application under 35 USC § 103(c).

Applicant stated in a March 9, 2009 amendment that:

"The present application and Cordery's U.S. Patent No. 5,628,249 assigned to Pitney Bowes Inc., were at the time of the invention of the present application, commonly owned by or subject to an obligation of assignment to the same entity, namely Pitney Bowes Inc."

Humes discloses the following in column 2, lines 39-61.

"...a machine for lowering the mailing costs of small volume merchants by producing bundles for low postal rate mailings which are made up of the commingled pieces from a plurality of merchants. The machine comprises, in the preferred embodiment, a first computer operable to combine the mailing lists of a plurality of merchants and group the addresses on the mailing lists according to the lowers postal rate. The first computer is further operable to generate the address information required by postal regulations, such as bar codes or zip+4 numbers, for each address; and to further assign a merchant-identifier tag to each address thus creating a merged data base of the merchants' mailing lists.

The first computer is further operable to generate documentation for the post office as well as individual client invoices. A second computer serves as a sequence controller to operate mail piece handling machinery according to the grouped addresses. The present invention further comprises the mail piece handling machinery for physical commingling and addressing of the different merchants non-alike pieces."

The examiner stated the following in page 15 of the Final Rejection.

**"Applicant argues** that Cordery patent is not available as prior art against the instant application under 35 USC § 103(c), because the instant application and Cordery's U.S. Patent No. 5,628,249 assigned to Pitney Bowes Inc., were at the time of the invention of the present application, commonly owned by or subject to an obligation of assignment to the same entity, namely Pitney Bowes Inc.

**In response** to this argument it is noted that Common Ownership of Assignee Prior Art Exclusion Under 35 U.S.C. 103(c), which disqualified subject matter under former 35 U.S.C. 103 via 35 U.S.C. 103(e) as prior art, was enacted on November 29, 1999, which is later than the effective date of the instant application, and, therefore, is ineffective for the instant application"

Applicant respectfully still discloses with the Examiner.

MPEP § 2146 states the following:

"These changes 35 U.S.C. 103(c) apply to all patents (including, reissue patents) granted on or after December 10, 2004. The amendment to 35 U.S.C. 103(c) made by the AIPA to change "subsection (f) or (g)" to "one of more of subsections (e), (f), or (g)" applies to applications filed on or after November 29, 1999. It is to be noted that, for all applications (including reissue applications), if the application is pending on or after December 10, 2004, the 2004 changes to 35 U.S.C. 103(c), which effectively include the 1999 changes, apply; thus, the November 29, 1999 date of the prior revision to 35 U.S.C. 103(c) is no longer relevant. In reexamination proceeding, however, one must look at whether or not the patent being reexamined was granted on or after December 10, 2004 to determine whether 35 U.S.C. 103(c) as amended by the CREATE Act, applies for reexamination proceeding of a patent granted prior to December 10, 2004 on an application filed on or after November 29, 1999, it is the 1999 changes to 35 U.S.C. 103(c) that are applicable to the disqualifying commonly assigned/owned prior art provision of 35 U.S.C. 103(c). See MPEP § 706.02(1)(1) for additional information regarding disqualified prior art under 35 U.S.C. 102(e)/103. For reexamination proceeding of a patent granted prior to December 10, 2004 on an application filed prior to November 29, 1999, neither the 1999 nor the 2004 changes to 35 U.S.C. 103(c) are applicable. Therefore, only prior art under 35 U.S.C. 102(f) or (g) used in a rejection under 35 U.S.C. 103(a) maybe disqualified under the commonly assigned/owned prior art provision of 35 U.S.C. 103(c)."

Thus, the Cordery patent is not prior art to the applicant.

Humes discloses the following in his Abstract:

"...The apparatus can take pre-printed, unaddressed mail pieces of non identical size delivered to the mailing service from different merchants and combine the mail pieces to create mailing bundles at the lowest postal rate and group the bundles to create a single mailing."

Humes discloses the following in lines 28-49 of col. 3.

As seen in FIG. 1, the apparatus of the present invention will be described as capable of handling four input sources 11,12,15,14. It will be appreciated that the apparatus is conveniently modularized and is not limited to four inputs. The input sources are merchants, or other mailing service customers, typically with different pieces, 17, 18, 19, 20 to have mailed; and different address lists, or data bases, 23, 24, 25, 26, to which the pieces must be mailed.

The data bases 23-26 are merged and sorted according to the lowest common postal rate by a digital data handling apparatus or apparatuses, hereinafter simply called first computer 29, as further explained below, to produce a merged data base 31. A second computer, hereinafter called a sequence controller 57, then uses the merged data base 51 in conjunction with other programming to control the piece handling machinery 33 used to physically commingle, address and segregate the pieces 17-20 into groups of packages, or bundles, constituting mailing 35 suitable for delivery to the post office 37 to be delivered at the lowest available postal rate.

Thus, Humes is a presort house that does not disclose a second printer that prints documents in accordance with characteristics selected at a first node.

The art cited by the Examiner does not disclose or anticipate, separately or together, the method and system of defining and producing the finished mail piece claimed by Applicants. Applicants claim a method and system that allow a user to select at a first node a plurality of characteristics that define a mailing. Once the selections have been made, the selected information is transmitted to a terminal node, wherein the terminal node is not co-located with or under the control of the first node so that the terminal node may control the time of production of mail pieces. The terminal node may also direct the production of mail pieces to mail production means for producing the

mail, wherein a second printer at the terminal node prints the document in accordance with the characteristics selected at the first node, and the printed document is inserted into an envelope to form an unfinished envelope which is subsequently franked. Hence, the mail piece may be directed to specific mail production means so that mail pieces may be produced efficiently or produced at a site that is closer to the recipient of the mail piece. Thus, the mail piece may be delivered in less time since it may be electronically transmitted to a site where it is produced and subsequently mailed from a site that is closer to the recipient.

The art cited by the Examiner for claim 1 and those claims dependent thereon, does not disclose or anticipate steps d, e, and g of claim 1, namely,

- (d) transmitting electronically said print job to a terminal node wherein said terminal node is not co-located with, nor under the control of, said first node;
- (e) receiving said print job at said terminal node, said terminal node for receiving said print job and for directing said print job to a mail production means for producing said mail piece, said mail production means further comprising:
  - (i) a first printer; and
  - (ii) a second printer;
- (g) printing on said second printer said document, wherein said document is printed in accordance with characteristics selected at said first node;

Regarding claim 15, the prior art cited by the Examiner does not allow one to control the time for producing a mail piece consisting of a document and an envelope that utilize transmitting means to transmit a mailing to second data processing means that are not co-located with or under the control of first data processing means. Furthermore, the document is printed at a second printer located at the second data processing means whereby the document is subsequently inserted into an envelope which is then sealed and franked to reduce the time for delivering the mail piece to a recipient. Thus, elements b, c, and e are not disclosed or anticipated by the art cited by the Examiner, namely:

- (b) transmission means for transmitting said mailing to a second data processing means wherein said second data processing means is not co-located with, nor under the control of said first data processing means;
- (c) second data processing means for receiving said mailing and downloading said mailing to a plurality of printer means comprising a first printer and a second printer;
- (e) second printer means comprising said second printer for printing said document to media selected at said first data processing means.

Regarding claim 20 the art cited by the Examiner does not define and produce a mailing by transmitting an electronic document, characteristics of a mailing produced at a first node, and an address list to a terminal node wherein the terminal node is not co-located with or under the control of the first node so that a document is printed in accordance with the characteristics selected at the first node. Then the document is inserted into a corresponding printed envelope and provided with evidence of postage payment.

The art cited by the Examiner for claim 20 and those claims dependent thereon does not disclose or anticipate the following steps of claim 20 as amended, namely creating a document and storing said document in electronic form;

transmitting said document, said address list and said characteristics to a terminal mode wherein said terminal [node] mode is not co-located with, nor under the control of, said first node;

printing said document in accordance with one or more of said characteristics selected at said first node;

providing said printed envelope with evidence of postage payment; and

Regarding claim 38 the art cited by the Examiner does not disclose a system for producing a mail piece that has second data processing means for electronically receiving said selected document, address list and characteristics and directing said selected document, address list and characteristics to a mail production means, wherein

said second data processing means is not co-located with, nor under the control of, said first data processing means;

said mail production means comprising first means for printing said selected document in accordance with one or more of said selected characteristics, second means for printing each of said destination addresses to a corresponding envelope, means for printing said corresponding envelope with evidence of postage payment, and means for inserting said printed document into a corresponding printed envelope.

Claims 2, 30, 31 and 33 have been rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Cordery, in view of Humes and further in view of Seki et al (US 5,121,195) and further in view of Lombardo (U.S. Patent 5,346,123).

Claim 2 is dependent on claim 1 and claims 30, 31 and 33 are dependent on claim 20. For the reasons indicated above in the discussion of claims 1 and 20, claims 2, 30, 31 and 33 are patentable.

Claims 3, 4, 35, 36, 44, 45, 46 and 48-50 have been rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Cordery, in view of Humes and further in view of Rosenbaum et al (US 5,031,223).

Claims 3 and 4 are dependent on claim 1, claims 35 and 36 are dependent on claim 20 and claims 44, 45, 46 and 48-50 are dependent on claim 38. For the reasons indicated above in the discussion of claims 1 and 38, claims 3, 4, 35, 36, 44, 45, 46 and 48-50 are patentable.

Appln. No.: 09/628,496  
Amendment Dated: July 24, 2009  
Reply to Office Action dated December 9, 2009

In view of the above, claims 1-21, 23-40 and 45-52 are patentable. If any questions should arise, will the Examiner please call the undersigned at the telephone number noted below.

Respectfully submitted,

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